

REMARKS

In a Final Office Action mailed January 21, 2005, the Examiner rejected claims 1-10, 12, 14, 17-20 under 35 U.S.C. 103 as being unpatentable by Legge et al (US 2002/0034978) and Lauper (WO 01/69548). The Examiner also rejected claims 11 and 15 under 35 U.S.C. 103(a) as being unpatentable over Legge and Lauper as to claim 1 and further in view of Eberhart (US 6404339). The Examiner further rejected claim 13 under 35 U.S.C. 103(a) as being unpatentable over Legge and Lauper as applied to claim 1 and further in view of Robinson (US 4591854). The Final Office action did not specifically address the previously added claims 21-23 but generally stated that claims 1-23 were rejected.

The Applicants have amended claims 1-23. The Applicants have made the above amendments to the claims and respectfully requests reconsideration of the pending claims in light of the amendments and the following remarks.

Claims 1, 17, 18 are independent claims. Amended independent claim 1 is now directed to *a promotional material* that comprises a visual aid that identifies a consumer product and a Radio Frequency Identification ("RFID") device. The RFID device has stored thereon an expiration and a set of data bits. The set of data bits are capable of being presented to a processing device via a RFID reader. This will cause the processing device to enable at least one feature that would otherwise be disabled in an electronic device (such as an electronic game console, a personal digital assistant, a cellular telephone or a pager). This electronic device has a plurality of features. The processing device will also disable the at least one feature when the expiration reaches a predetermined value. Claim 1 further states that the at least one feature (being enabled) is an *improvement* to a performance or a characteristic of the electronic device (such as new powers, capabilities, characters, calendar updates, or the like). Support for this additional language can be found at least in the Specification at page 4, lines 1-7; page 4, lines 20-30; page 10, lines 22-28.

Independent claim 17 was amended similar to claim 1 in that it also recites *a promotional material* that comprises a visual aid that identifies a consumer product and a RFID device. Additionally, claim 17 recites that the at least one feature being enabled is an improvement to a performance or a characteristic of the electronic device. Claim 17 further recites that the RFID device has stored a counter. Here, the set of data bits presented to the processing device causes the

processing device to disable at least one feature that would otherwise be enabled in the electronic device. And, the processing device enables the at least one feature when the counter reaches a predetermined value.

Amended Independent claim 18 is also directed to a *promotional material* that comprises a visual aid that identifies a consumer product and a RFID device. The RFID device has stored thereon a counter and a set of data bits. The set of data bits, when presented to a processing device via a RFID reader, causes the processing device to *enhance* at least one feature in an electronic device. Again the electronic device has a plurality of features and the at least one feature is an *improvement* to a performance or a characteristic of the electronic device.

As described in the Applicants' specification:

The promotional material 100, with the attached RFID device(s) 102, can be used in a number of ways. In the simplest form, the promotional material 100 becomes a visual aid identifying to the consumer 200 the specific product tailored to their preferences. In a more complex form, the promotional material becomes an 'active' coupon(s) allowing the promotional incentive programmed into the RFID device(s) 102 to be modified/enhanced at the point-of-decision or point-of-redemption by the consumer.

[Applicant Specification, page 10, lines 22-28]

Accordingly, unlike traditional systems, the present invention performs multiple functions. For instance, one function is that the promotional material serves as a visual aid identifying to the consumer a specific product. Another function is that the promotional material serves as an active coupon that increases the functionality of a product or game. With respect to increasing functionality of a product or game – the claims recite that there is an *improvement* to a performance or a characteristic of the electronic device (such as new powers, capabilities, characters, calendar updates, or the like). The Applicants respectfully submit that these items are not taught in the cited prior art references.

Legge describes a system that only allows or disallows access to an attraction, game, or area. For instance, Legge describes an activity station (40) that can be connected to a coin mechanism of a coin-operated machine (paragraph 36), or connected to an automated ticket dispenser (paragraph 37), or placed at each attraction at an amusement park (paragraph 59). Event criteria is placed on a

client transponder card (20) (paragraph 41). Legge explains that “[i]f the event criteria permit and the proper credits are available, the activity station 40 will activate the coin mechanism of the machine (100) for game play” (paragraph 46). In the amusement park example, Legge explains that “[i]f access is granted, the customer 200 can pass through the access control system 220, a turnstile here” (paragraph 60). Legge, however, fails to teach having data on the transponder card that changes the way a game is played, or the manner in which a ride operates. Legge further fails to teach that the RFID device is part of promotional material that has a visual aid identifying to the consumer a specific product.

The Office Action also cites Lauper for the proposition that it teaches a RFID card as a SIM card in a cellular telephone system. The Office Action states that the SIM card adds features, like dialing through a service provider, as satisfying the improved functionality of the cellular telephone. Lauper is similar to Legge in that the SIM card simply provides access to a service. Furthermore, Lauper fails to teach that the RFID device is part of promotional material that has a visual aid identifying to the consumer a specific product.

In contrast, the claimed invention is different in that a set of data bits on the RFID device *enhances* at least one of many features of an electronic device. This feature is described in the claims as an improvement to a performance or a characteristic of the electronic device. [e.g., Specification, Page 15, Lines 14-16] The claims also recite an expiration or counter that turns off the feature that provides the enhancement or improvement to the electronic device. Additionally, the claims recite that the RFID device is part of promotional material that has a visual aid identifying to the consumer a specific product. [e.g., Specification, page 10, lines 22-28] The Applicants’ respectfully submit that items are not taught in the cited references.

The benefit of coupling these recitations together is to allow manufacturers and sellers to associate the RFID device with a promotional material for a consumer product. The RFID device provides consumers of the product -- who already have access and use of an electronic device -- the ability to improve the performance and characteristics of the electronic device. The RFID device can dynamically change the nature of an electronic device depending on the data bits on the RFID device. This may change the way a game is played depending upon the data in the presented RFID device.

For instance, Page 16 of the Specification describes that the RFID device can be programmed to enable new powers or capabilities of a game. In particular, a code can be preprogrammed prior to distribution of the product. Later, the code may be updated with advertising gimmicks such as "this week's" game power. An exemplary benefit of allowing the RFID device to be programmed this way encourages consumers to purchase a new product each week so as to obtain the latest game power. [Specification, Page 16, Lines 3-16]

It is respectfully submitted that Legge and Lauper fail to teach any improvements to the nature of games, rides, or other activities after a user already has access. Moreover, Legge and Lauper does not teach having these types of improvements tied to an expiration or counter. Furthermore, Legge and Lauper fail to teach a RFID device that is part of promotional material that has a visual aid identifying to the consumer a specific product. Accordingly, the Applicants believe that there are patentable distinctions in the recited claims.

Pending claims 2-16, 21-23 depend on independent claim 1. Pending claims 19-20 depend on independent claim 18. These dependent claims are believed to be allowable for at least the same reasons discussed above.

As the Applicants believe that the amendments overcome all substantive rejections and objections given by the Examiner and have complied with all requests properly presented by the Examiner, the applicants contend that this Amendment, with the above discussion, overcomes the Examiner's objections to and rejections of the pending claims. Therefore, the applicants respectfully solicit allowance of the application. If the Examiner is of the opinion that any issues regarding the status of the claims remain after this response, the Examiner is invited to contact the undersigned representative at (847) 862-0153.

Respectfully submitted,
Miles R. Jackson, et al.

By: 

Thomas V. Miller
Attorney for Applicant
Registration No. 42,002
Phone No.: 847/862-0153
Fax No.: 847/576-3750